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| 09/706,158      | 11/03/2000  | Tor McPartland       | 57974-5002          | 6455             |

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EXAMINER

PRYOR, ALTON NATHANIEL

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1616

DATE MAILED: 09/08/2003

*M*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/706,158

Applicant(s)

MCPARTLAND, TOR

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 8 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 26 is/are allowed.
- 6) ☐ Claim(s) 17-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Liebman (CA 2060594; 8/6/92). Liebman teaches a method of applying a shampoo or lotion composition comprising d-limonene, emulsifiers (cocamido propyl betaine, sodium lauryl sulphate, ethyl methacrylate) and water and/or alcohol to human head / hair / skin to contact lice. Leibman teaches that the method is used to prevent lice infestation in human hair and skin. See page 1 lines 5-8, page 3 lines 5 – 22, page 6 examples.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 17, 18, are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkins, Jr (5951991; 9/14/99). Wilkins, Jr. teaches a method of applying a composition

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comprising 2-10% d-limonene, 2-10% emulsifier, and 80-96% water to crop or plants to control fire ant infestation. See abstract, column 2 line 1 – column 3 line 35.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liebman as applied to claims 17 and 20 above in view of Synder (US 6063771; 5/16/00). See Liebman's 35 USC 102(b) rejection above. Liebman teaches all that is recited in claims 21-24 except for a lotion comprising a castor oil and the instant amount ranges of d-limonene, castor oil and emulsifier. However, Synder teaches a method of applying a lotion composition comprising PEG-castor oil to human skin to control lice. It would have been obvious to modify the lotion taught by Liebman to include the PEG-castor oil taught by Synder. One would have been motivated to do this to enhance the consistency of the lotion taught by Liebman. With respect to instant amount ranges of said ingredients, one having ordinary skill in the art would have been expected to determine the optimum amount of ingredients for the invention. One would have been motivated to do this in order to make the most effective lotion to prevent lice infestation on human skin.

Claims 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins, Jr. as applied to claims 17 and 18 above. See Wilkins, Jr.'s 35 USC 102(e)

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rejection above. Wilkins, Jr. teaches all that is recited in claims 19 and 25 except for the instant composition comprising the % d-limonene and except for the plants being rose bushes and ornamentals. Wilkins, Jr. teaches 2-10% d-limonene; whereas, the instant claims uses a high of 1.5% d-limonene. In the absence of unexpected results, one having ordinary skill in the art would expect Wilkins' composition comprising 2% d-limonene to yield similar if not the same results as the instant composition comprising 1.5% d-limonene which is just slightly below 2%. With respect to rose bushes and ornamentals, said plants are species within the plant genus; and therefore it would have been obvious to one having ordinary skill in the art to apply the instant method to said named plants. One would have been motivated to do this since rose bushes and ornamentals are species within the plant genus.

#### ***Allowable Subject Matter***

Claim 26 is allowable. The prior art does not teach or suggest a method of controlling fire ants with a composition consisting essentially of the instant amounts of d-limonene, emulsifier, hydrophilic solvent, and preservative.

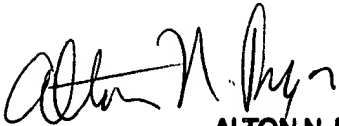
#### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 703 308-4691. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703 308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

A handwritten signature in black ink, appearing to read 'Alton N. Pryor', is written over the printed name.

**ALTON N. PRYOR**

Alton Pryor **PRIMARY EXAMINER**  
Primary Examiner  
AU 1616